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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,685	09/30/2004	Greg A. Hanlon	PES-0220	5684

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CANTOR COLBURN, LLP
55 GRIFFIN ROAD SOUTH
BLOOMFIELD, CT 06002

EXAMINER

LEE, CYNTHIA K

ART UNIT	PAPER NUMBER
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1745

DATE MAILED: 12/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/711,685

Applicant(s)

HANLON ET AL.

Examiner

Cynthia Lee

Art Unit

1745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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This Office Action is responsive to the amendment filed on 12/14/2005. Claims 1-22 are pending. Claims 1,8,9,13, and 20 have been amended. Applicant's arguments have been considered, but are not persuasive. Thus, the previous 35 USC 102 and 103 rejections are maintained and claims 1-22 are finally rejected for reasons of record.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,6,7 of copending Application No. 10985633. Although the conflicting claims are not identical, they are not patentably distinct from each other. Claim 1 of the instant application and claims 1,6, 7 of the copending application claim a bipolar plate wherein the first side comprises a fluid flow region in communication with a first set of ports; the second side comprises a fluid flow region in communication with a second set of ports, and another layer in between the first and second side comprising first set of fluid flow channels in

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communication with the first fluid flow region and second set of fluid flow channels in communication with the second fluid flow region. The copending application does not disclose the orientation of the fluid flow region to be in different directions. However, it is obvious because is well known in the art to orient the two flow regions in different directions (see Faita et. al. col. 2, lines 20-25). Therefore, claim 1 of the instant application fully encompasses claims 1,6,7 in the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims Analysis

Regarding claims 17 and 21, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, the diffusion bonding and lamination of the bipolar plates has been considered but was not given patentable weight. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113.

Further, the examiner notes that the claimed layers in the bipolar plate are present as one layer in the final product, since the applicants do not specify that each layer comprises a different material. Therefore, the limitation of the layers was considered, but was not seen as a distinction over prior art comprising one layer.

The examiner has interpreted the term "through channel" to mean "the presence of a slot or a hole that is made in the respective part (layer)" as disclosed in the specification (para. 28).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 8-13, 16-22 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Faita et. al. (US 5565072).

With respect to claim 1, Faita discloses a bipolar plate with a first and second side comprising grooves (through channels) (15:66-67) and holes (ports) (3 in fig. 2) connected by distribution channels (header channels) (3 in fig 2). Further, Faita's grooves on each side of the plate by design are not in communication because one side is for the anode gas and another side is for the cathode gas (12:54-63). Although Faita does not expressly disclose the second side fluid flow configuration (fig. 2), the fact that the grooves are present on the second side (15:66-67) indicates that the fluid flow configuration on the second side is the same as the first side, incorporated in the entire Office Action herein.

The examiner has considered the limitations of the bonded layers of the bipolar plate. However, the applicants' bipolar plate was not distinct from Faita's invention for the reason stated above.

With respect to claim 2, the grooves are at 90° from each other (15:66-67).

With respect to claim 3, the inlet and outlet holes on each side (ports) are diagonally placed from each other (fig. 2).

With respect to claim 8, Faita's distribution (header) channels (3 in fig. 2) extend from the grooves (through channels) (15:66-67) in the active area of the bipolar plate to the holes (ports) on each side (2 in fig.2).

With respect to claim 9, the four distribution channels (two on each side of the plate) in Faita's bipolar plate are isolated from each other (fig. 2).

With respect to claim 10, the limitation of the diffusion bonding of layers was considered, but was not seen as distinct from Faita for the reason stated above.

With respect to claim 11, Faita's distribution (header) channels comprise a plurality of header channels (fig. 2).

With respect to claim 12, Faita discloses that his plates are made of titanium (6:8).

With respect to claim 13, Faita discloses an electrochemical cell comprising an alternating arrangement of membrane electrode assemblies (MEAs) (6 and 7 in fig. 6) and bipolar plates (16 in fig. 6) between separator plates (17 in fig. 6), said bipolar plate with a first and second side comprising grooves (through channels) (15:66-67) and holes (ports) (3 in fig. 2) connected by distribution channels (header channels) (3 in fig 2), wherein the grooves are at 90° from each other (15:66-67). Faita's bipolar plates comprise inlet and outlet holes (ports) that connect the grooves (15:66-67) by the distribution channels (3 in fig. 2). Further, Faita's grooves on each side of the plate by design are not in communication because one side is for the anode gas and another

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side is for the cathode gas (12:54-63). Although Faita does not expressly disclose the second side fluid flow configuration (fig. 2), the fact that the grooves are present on the second side indicates that the fluid flow configuration on the second side is the same as the first side.

The examiner has considered the limitations of the bonded layers of the bipolar plate. However, the applicants' bipolar plate is not seen to be distinct from Faita's invention for the reason stated above.

With respect to claim 16, Faita's MEA comprises an oxygen electrode and a hydrogen electrode (7 in fig 6); and the first layer of the bipolar plate is proximate the oxygen electrode (18 in fig. 6). Although Faita does not expressly disclose that his electrodes comprise an oxygen and a hydrogen electrode, Faita teaches that the gases fed to the bipolar plates are fed to the anode and cathode compartments (12:54-63). Thus, Faita's electrodes must teach an anode and a cathode.

With respect to claim 17, the limitation of the diffusion bonding of layers was considered, but was not given patentable weight for the reason stated above.

With respect to claims 18 and 19, Faita discloses bipolar plates with grooves (through channels) (15:66-67). Since the bipolar plates in Faita's Example 5 referred to the same bipolar plates as in Example 1, which refers back to the figures, Faita's grooves must be located in the flat region located in the center of the bipolar plate in which a gasket seals around the border, the grooves, and the inlet and outlet holes (ports) (figs. 2 and 3; 6:27-35). Although Faita does not expressly disclose the second side fluid flow configuration (fig. 2), the fact that the grooves are present on the second

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side (12:54-63) indicates that the second side must have the same configuration of the first side.

With respect to claim 20, Faita discloses an electrochemical cell comprising a an alternating arrangement of membrane electrode assemblies (MEAs) and bipolar plates between separator plates (17 in fig. 6), said bipolar plate with a first and second side comprising grooves (through channels) (15:66-67) and holes (ports) (3 in fig. 2) connected by distribution channels (header channels) (3 in fig 2), wherein the grooves are at 90° from each other. Faita's bipolar plates comprise inlet and outlet holes (ports) that connect the grooves (15:66-67) by the distribution channels (3 in fig. 2). Further, Faita's grooves on each side of the plate by design are not in communication because one side is for the anode gas and another side is for the cathode gas (12:54-63). Although Faita does not expressly disclose the second side fluid flow configuration (fig. 2), the fact that the grooves are present on the second side (15:66-67) indicates that the fluid flow configuration on the second side is the same as the first side

The examiner has considered the limitations of the bonded and laminated layers of the bipolar plate. However, the applicants' bipolar plate is not distinct from Faita's invention for the reason stated above.

With respect to claim 21, the limitation of the diffusion bonding of layers was considered, but was not given patentable weight for the reason stated above.

With respect to claim 22, Faita discloses that the bipolar plates made of titanium or stainless steel (6:7-15).

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4,5, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Faita et. al. as applied to appropriate claims above, and further in view of Wilson (US 2004/0197630).

The applicant is claiming a thickness of layers. Since the layers do not exist in the final product, the examiner has interpreted the thickness to be the thickness between the valley of the grooves on each side of the plate.

Wilson discloses a bipolar plate with a channel width of 0.8 mm and depth of 0.25 mm (0031; 0033, lines 5-6), thus clearly teaching that the groove dimensions are result effective variables. It has been held by the courts that discovering an optimum value or workable ranges of a result-effective variable involves only routine skill in the art, and thus not novel. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). See MPEP 2144.05. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the grooves on Faita's bipolar plates with the groove dimensions for the purposes of fine tuning the pressure drop of the reactant gases and improving the overall performance of the plate, as taught by Wilson (0031 lines 4-6; 0032 lines 5-8).

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Claims 6,7,15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Faita et. al. as applied to appropriate claims above, and further in view of Toshihiro (JP 05-251097).

Toshihiro discloses a bipolar plate wherein the plate comprises grooves of different lengths, in which an upstream portion of a first side of the plate has one width and a downstream portion of the first side has a second width (fig. 1). This configuration was designed by Toshihiro so that the stay of condensed water in the gas channel grooves in the bipolar plate can be eliminated to eject the water quickly (abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Faita's grooves with two of Toshihiro's bipolar plate facing back to back of each other wherein the larger width of the two widths on the first side is greater than the smaller width on the second side. The motivation would be for the purpose of improving condensed water elimination, as taught by Toshihiro.

Response to Arguments

Applicant's arguments filed 12/14/2005 have been fully considered but they are not persuasive. The 35 USC 112, 2nd paragraph rejection has been withdrawn.

Applicant traverses the double patenting rejection (pg. 8) because the copending application is not prior art. However, double patenting rejection does not require a copending application/patent be prior art. In general, the prior art status is irrelevant to double patenting rejections. Thus, the double patenting rejection is maintained.

The Office acknowledges that the through channels present on the applicant's first and second layer are "holes" that penetrate through the first and second layer.

However, the Office notes that the “holes” become merely an indent or a groove once all three layers are laminated. Thus, Faita’s grooves have been found to read on applicant’s limitations “through channels” on first and second layers.

Applicant points out that (pg. 11) “it is unclear how one skilled in the art would arrive at the through-hole structure of the middle layer if the entire plate is considered to be a single layer.” As illustrated in fig. 2 and 3 of Faita, it is noted that when the bipolar plate (1) assembles with the gasket (8), the distribution channels (3) on the bipolar plate coincide with the channels (11) of the gasket and Faita’s distribution channels becomes enclosed, thus meeting applicant’s limitation “through channels” on the third layer.

Applicant points out (pg. 10) the advantages associated with forming the plate with laminated layers. However, “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113. Further, it has been held that only “the structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over prior art.” See MPEP 2113. The Office notes that the claimed layers in the bipolar plate are present as one layer in the final product, since the applicants do not specify that each layer comprises a different material. Thus, applicant’s laminated layers are not seen as distinct over Faita’s plate comprising one

layer. Further, findings of an additional advantage associated with doing what the prior art suggests does not lend patentability to an otherwise unpatentable invention. See *In re Linter*, 458, F.2d 1013, 173 USPQ 560 (CCPA 1972) and *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990). See MPEP 2145.

Applicant argues that claims dependent on claim 1 and 13 are allowable for at least the reason that they depend from allowable claims. However, applicant's arguments regarding claim 1 and 13 are not persuasive, and claim 1 and 13 and their dependent claims are not found allowable.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Lee whose telephone number is 571-272-8699. The examiner can normally be reached on Monday-Friday 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ckl

Cynthia Lee

Patent Examiner


PATRICK JOSEPH RYAN
SUPERVISORY PATENT